

REMARKS

Power of Attorney

The Applicant submitted a *Revocation and Power of Attorney* for this matter on October 23, 2009. The Examiner is respectfully requested to enter this new power of attorney into the file thereby recognizing the attorneys and agents of customer number 22830—Carr & Ferrell LLP—as the attorneys of record. New counsel looks forward to working with the Examiner in an effort to bring the present matter to a mutually agreeable conclusion.

Amendments to the Claims

The Applicant has made a number of amendments to the claims for the purpose of increasing grammatical clarity. For example, instances of ‘said’ have been replaced with the definite article ‘the.’ The recitation of certain adverbs in the claims (e.g., simultaneously) have been ‘repositioned’ such that the adverb is located adjacent to the verb being modified.

Further, the preambles of the various dependent claims have been ‘shortened’ such that they merely refer to the statutory class of the independent claim from which they otherwise depend. This ‘shortening’ of the dependent claim preambles does not, however, change the scope of the claim in that a dependent claim incorporates by reference the subject matter of the claim from which it depends by virtue of 35 U.S.C. § 112, ¶ 4.

While less cosmetic in nature, certain dependent claim limitations have been amended such that system claims recite ‘system’ type elements rather than a method step prefaced by ‘providing.’ For example, claim 112 concerns the system of claim 108, but recited ‘providing a component.’ The ‘providing’ limitation has been eliminated such that the

claim now recites the component, which is appropriate in the context of a system claim. Similarly, in claims 102 and 103, the limitation of ‘further comprising placing advertising’ has been amended to recite ‘wherein an advertisement is placed.’ Such an amendment is appropriate in that claims 102 and 103 both depend from claim 99, which is a system claim. By reciting the conjunction ‘wherein,’ the claim is not only grammatically correct but consistently refers to the same class of subject matter (*i.e.*, a system versus a method).

Notwithstanding these amendments, a further search and/or examination is not believed to be necessary in that the scope of the claimed subject matter has not been amended to require the same.

Information Disclosure Statement

The Examiner has issued what is being characterized as a request under 37 C.F.R. § 1.105 requesting “[a]n information disclosure statement to replace the information disclosure statement filed June 29, 2009.” *Office Action*, 3. The Applicant will be submitting the same within the coming days and before the Examiner takes up the present application for further consideration. The replacement statement is, however, not a ‘pared’ down statement—as requested—but a more complete and legible statement for the Examiner’s consideration.

The Examiner also requests that the disclosure statement eliminate “clearly irrelevant and marginally pertinent cumulative information” and that “those documents which have been specifically brought to [the] applicant’s attention and/or are known to be of most significance are highlighted.” *Office Action*, 3. The Applicant—with the utmost respect and sympathy for the Examiner—must decline this request on the grounds that it is not required of the Applicant and imposes an obligation to proffer an opinion that is otherwise not required by the Applicant.

The present application is from a 'family' of applications presently involved in litigation in the United States District Court of Delaware. Charges of inequitable conduct were raised during this (and subsequently filed and dismissed litigations) alleging that the Applicant had engaged in inequitable conduct during the course of prosecution. As was expressly noted by Judge Lourie in *Molins PLC v. Textron Inc.*, "unjustified accusations of inequitable conduct" constitute a "'plague' on the patent system." 48 F.3d 1172, 1182 (Fed. Cir. 1995); see also *Burlington Indus., Inc. v. Dayco Corp.*, 849 F.3d 1418, 1422 ("charging inequitable conduct in almost every major patent case has become an absolute plague"). The Examiner even makes reference to Judge Lourie's decision in *Molins PLC*. See *Office Action*, 3 (citing *Molins PLC*). In that regard, the Applicant submitted the aforementioned disclosure statements out of an abundance of caution to combat such unfounded accusations should a patent issuing from this application ever be asserted in litigation. The Applicant truly appreciates the Examiner's efforts and the burden that this places upon the Examiner, but the current state of patent litigation has necessitated the same.

Notwithstanding the cause of the large submission, the Applicant respectfully contends that it is under no duty to declare a particular reference to be irrelevant or marginally pertinent. Likewise, the Applicant respectfully contends that it is under no duty to identify a particular reference that is of the 'most significance.' The Applicant is required to comply with the charge set forth in Rules 56, 97, and 98. The Applicant believes that it has satisfied that charge.

Further, the Code of Federal Regulations states that "[t]he filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b)." 37 C.F.R. § 1.97(h). The MPEP further notes that "[i]ndividuals associated in a substantive way with the filing and prosecution of a patent application are encouraged

to submit information to the Office so the Examiner can evaluate its relevance to the claimed invention.” MPEP 609 (emphasis added).

Also in this regard, it is noted that Rule 105 only permits queries related to *factual* information—not a request for an opinion. See 37 C.F.R. § 1.105(a). Further, Rule 105(a)(3) states as follows:

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

- (i) A requirement for factual information;
- (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (iii) Stipulations as to facts with which the applicant may agree or disagree.

The MPEP likewise supports the Applicants contention as a requirement for information must be for *factual* information—“requirements under 37 CFR 1.105 are **not requesting opinions** that may be held or would be required to be formulated by applicant.” MPEP 704.11.

The Applicant therefore submits that the Applicant is not required to admit or opine on the pertinence or materiality of any particular reference. The Applicant appreciates the large number of references cited in the aforementioned (and forthcoming) information disclosure statements and wishes to express its appreciation to the Examiner for taking the time to evaluate each of the aforementioned references as otherwise required by the MPEP and C.F.R.

35 U.S.C. § 101 Rejection

The Examiner rejected claims 118, 120-122, 124-129 under Section 101 as constituting unpatentable subject matter. See *Office Action*, 5. The Applicant has cancelled these claims (without prejudice) thereby making the Examiner's rejection moot. The Applicant has cancelled these claims solely for the purpose of expediting examination. Cancellation should not be construed as acceptance or concurrence with the Examiner's rejection.

35 U.S.C § 103(a) Rejection

The Examiner rejected claims 28-37, 118-126, 128, and 129 as being unpatentable under Section 103. See *Office Action*, 8. The Applicant has cancelled these claims (without prejudice) thereby making the Examiner's rejection moot. The Applicant has cancelled these claims solely for the purpose of expediting examination. Cancellation should not be construed as acceptance or concurrence with the Examiner's rejection.

Allowable Subject Matter

The Examiner has identified claims 78-117 as constituting allowable subject matter. See *Office Action*, 16. The Applicant thanks the Examiner for this identification and but for certain grammatical amendments referenced above, these claims remain presented and ready for allowance.

CONCLUSION

The Applicants have cancelled all claims rejected under Sections 101 and 103. As a result, only claims embodying allowable subject matter as identified by the Examiner remain. The Applicants have, however, made certain amendments to improve the clarity and grammatical correctness of those claims.

The Applicant respectfully contends that a request for information under Rule 105 does not require the Applicant to opine on the relevance of references. As such, the Applicant respectfully declines the Examiner's request. Again, the Applicant truly sympathizes with the volume of references, but the need for such a voluminous disclosure is the result of litigation and re-examinations instigated by third-parties. The Applicant will, however, be submitted a new 'clean' information disclosure statement, which will hopefully make the Examiner's duty of review that much easier.

As only allowable subject matter remains in the present application, allowance is respectfully solicited.

Respectfully submitted,
Lakshmi Arunachalam

December 18, 2009

By: /Tam Thanh Pham
Tam Thanh Pham (50,565)
Carr & Ferrell LLP
2200 Geng Road
Palo Alto, CA 94303
650.812.3400
650.812.3444